



IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Application of: HAHN, et al.
Serial No.: 09/848,923
Filing Date: May 3, 2001
Group Art Unit: 2665
Examiner: Alpus Hsu
Title: **METHOD AND SYSTEM FOR MANAGING TIME-
SENSITIVE PACKETIZED DATA STREAMS AT A
RECEIVER**

MAIL STOP AF
Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Dear Sir:

PRE-APPEAL BRIEF REQUEST FOR REVIEW

The following Pre-Appeal Brief Request for Review ("Request") is being filed in accordance with the provisions set forth in the Official Gazette Notice of July 12, 2005 ("OG Notice"). Pursuant to the OG Notice, this Request is being filed concurrently with a Notice of Appeal. Applicants respectfully request reconsideration of the Application in light of the remarks set forth below.

REMARKS

In the prosecution of the present Application, the Examiner's rejections and assertions contain clear errors of law, including a failure to establish *prima facie* rejections in a Final Office Action. To assist the Panel in the review of this Request, Applicants submit the following brief summary of selected portions of the prosecution history of the Application.

I. Final Office Action

In a Final Office Action of June 24, 2005, all pending claims were rejected under 35 U.S.C. §112, but as described in further details below, the Final Office Action failed to set forth a *prima facie* rejection of the claims.

II. Errors of Record

Most notable of the legal errors present in the examination of the Application is a failure of the Final Office Action to establish a *prima facie* rejection of all the claims in the application.

The Final Office Action rejects Claims 1-6, 9-16, 19-26, 29 and 30 under 35 U.S.C. § 112, first paragraph, as failing to comply with the enablement requirement. The Examiner alleges that the claim(s) contain subject matter which was not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention.

As described in the previous response dated August 22, 2005, Applicants submit that the disclosure contains sufficient information regarding the subject matter of Claims 1-6, 9-16, 19-26, 29 and 30 so as to enable one skilled in the pertinent art to make and use the claimed invention without undue experimentation, which is the standard for enablement. (See M.P.E.P. § 2164.01).

The Examiner states at page 7 of the Final Office Action that certain steps are required "before the energy levels of payload signals of current packet and previous packet can be compared to determine whether to drop or play the packet." "[A]n enablement rejection based on the grounds that a disclosed critical limitation is missing from a claim should be made only when the language of the specification makes it clear that the limitation is critical for the invention to function as intended." (M.P.E.P. § 2164.08(c)). Nowhere in Applicant's disclosure does it state that any step or condition is "required" or "critical" to the

claimed invention. In fact, the steps indicated by the Examiner at page 7 of the Final Office Action are evidence that one skilled in the relevant art would be able to practice the invention without undue experimentation.

III. Request for Relief from Errors

As a *prima facie* rejection has not been established against Claims 1-6, 9-16, 19-26, 29 and 30, Applicants respectfully request a finding of allowance of Claims 1-6, 9-16, 19-26, 29 and 30.

CONCLUSION

If the PTO deems that an interview is appropriate, Applicants would appreciate the opportunity for such an interview.

To the extent necessary, the Commissioner is hereby authorized to charge any required fees or credit any overpayments to Deposit Account No. 02-0384 of BAKER BOTTS L.L.P.

Respectfully submitted,

BAKER BOTTS L.L.P.

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Date: September 20, 2005

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